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09/709,143	11/10/2000	William C. Tate	81803F-P	3253

1333 7590 10/20/2004

PATENT LEGAL STAFF  
EASTMAN KODAK COMPANY  
343 STATE STREET  
ROCHESTER, NY 14650-2201

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/709,143  
Filing Date: November 10, 2000  
Appellant(s): TATE, WILLIAM C.

\_\_\_\_\_  
Frank Pincelli  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 29, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Appellant has not stated if the claims of the group do not stand or fall together. For purpose of appeal, the Examiner has chosen claim 14. Appellant asserted that there is two issues, the Examiner does not concur because of Appellant's grouping. Therefore, the only issue is 35 U.S.C. §102(e).

**(7) Grouping of Claims**

The rejection of claims 1-36 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Claim 14 has been taken as representative of Group I claims.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

6,321,231	Jebens et al.	11-2001
6,388,732	Williams et al.	05-2002

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14-16, 18-26 and 28-29 are rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,321,231 to Jebens et al. This rejection is set forth in a prior Office Action, mailed on March 9, 2004.

Claims 1-13, 17, 27, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,321,231 to Jebens et al. and further in view of U.S. Patent No. 6,388,732 to Williams et al. This rejection is set forth in a prior Office Action, mailed on March 9, 2004.

**(11) *Response to Argument***

Appellant remarks that the figures cited in Jebens "relied upon by the Examiner do not teach or suggest providing both static and dynamic sections" (Appellant's Brief page 3, first bridging). Furthermore, Appellant remarks that Jebens does not teach or suggest "that an e-mail is sent to a recipient that includes both static and dynamic portions such that only upon opening the e-mail will the dynamic portion then be sent to

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the recipient" (Appellant's Brief page 3, fourth indent), Appellant is assuming that the automatically forwarding to the receiving site only upon opening of the e-mail is from Appellant's said server, which is not recited in the claims.

Jebens does show dynamic portions being sent to the jobber site (recipient) from a local host site only upon opening the e-mail. Had the Appellant claimed the dynamic portion then be sent from said server to the recipient, then the Examiner would agree that Jebens would not read on the recited claim. However, Appellant does not claim this and the Jebens reference meets the metes and bounds of the broadly recited claim language.

The Examiner has provided a more detailed explanation of the workings of Jebens. Jebens discloses when a user wishes to place an order a custom e-mail form is downloaded and is completed (col. 21, lines 61-67). The user may include images and attachments to be included in the work order (col. 22, lines 1-2; col. 22, lines 13-14). When the work order is complete, the user will send a notification to the selected jobber 16 that a work order has been sent which may be via e-mail (col. 22, lines 24-31). The user will then send the work order by selecting the "Send" option (col. 22, lines 34-35). When the "Send" option is selected, the user's computer will prepare the work order by locating any attachments and the filenames of the images. The work order is compressed for efficient transmission to the host site. (Col. 22, lines 36-42) The work order is parsed for the identification of the images to be included in the work order and the name of the jobber/supplier 16 (col. 22, lines 43-46). The assembled work order with the included attachments and images are automatically transferred to a sending

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hot-folder associated with the selected destination (col. 22, lines 50-54). The hot-folder system compresses the work; establishes a connection with the jobber site by automatically dialing or sending a network request; establishes a valid communication link; and transmits the work order (col. 22, lines 58-63). The work order remains stored on the host system until it is completely transmitted and an acknowledgement is received (col. 22, lines 63-66). The jobber site 16 receives the e-mail notification of the work order transmission from the mail server (Figure 10I; col. 23, lines 9-11). The hot-folding software which includes the decompressed work order (block 864) and is stored to the appropriate incoming folder (block 866) is sent via LAN or WAN from the host site to the jobber site (Figure 10I). Such e-mail notification which is sent from the mail server and the work order is sent via LAN or WAN of the host site anticipate the recitation in claim 14 "providing both static and dynamic sections" and that "an e-mail is sent to a recipient that includes both static and dynamic portions such that only upon opening the e-mail will the dynamic portion then be sent to the recipient".

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Marissa Thein  
Patent Examiner  
Art Unit 3627

mtot  
October 18, 2004

Conferees

Michael Cuff *MC*  
Primary Examiner  
Art Unit 3627

Joseph Thomas *J. G. W. For J. J.*  
Appeal Conference Specialist *10-18-04*  
Technology Center 3600

PATENT LEGAL STAFF  
EASTMAN KODAK COMPANY  
343 STATE STREET  
ROCHESTER, NY 14650-2201

*Michael Cuff* 10/18/04  
MICHAEL CUFF  
PRIMARY EXAMINER